

## REMARKS

In the Office communication mailed on October 10, 2008, the Examiner addressed Claims 12, 20-24 and 26-31. The Examiner required corrections to Claims 12 and 26 to remove informalities and rejected those claims and their dependents under 35 U.S.C. 112, second paragraph owing to those informalities. The Examiner further rejected the claims under the same law on the grounds that the phrase “higher level” is indefinite.

The Examiner maintained a rejection of Claims 12, 20-24 and 26-31 under 35 U.S.C. 102(e) on the grounds that “the properties of regulating the expression of a drought or cold tolerance gene in a plant are...inherent to Harper *et al.*[’s] method of expressing SEQ ID NO: 2316 in the transgenic plant because the active method steps recited in the instantly claimed methods are structurally identical to the method steps disclosed in [the] Harper *et al.* method.” (Page 4 of the Office Communication).

Applicants respond as follows:

### **I. The Claims As Amended Remove The Examiner’s Objections To The Claims.**

In order to advance the prosecution of this case, but not by way of acquiescence in the Examiner’s arguments, and hereby reserving the right to prosecute the unamended claims (or similar claims) in the future, Applicants have canceled Claims 12 and 26 in favor of new Claims 32 and 34. The new language renders moot the Examiner’s first objection to the claims, and adopts the Examiner’s suggestion regarding introducing the term “stress condition.”

## **II. The Claims As Amended Remove The Basis For Their Rejection Under 35 U.S.C. 112.**

It is believed that the new language moots the Examiner's rejections relating to Applicants' alleged omission of essential steps and to Applicants' use of "at a higher level."

Antecedent basis for Claim 34, drawn to a method for increasing tolerance to a cold-stress condition by effecting expression of a binding protein (*e.g.*, SEQ. ID NO:1) in a plant such that expression of cold-tolerance genes is stimulated by exposure to a cold-stress condition, is supported, for example, by Paragraph [000104] of the application as published on April 22, 2004 (2004-0078852), with particular reference to Table 1. Table 1 lists 31 cold-responsive genes whose transcription is related to the expression product of SEQ ID NO:1 and *not* to the expression of CBF1, 2 and 3 (See Table 4).

Some of these 31 genes are also drought-responsive. The dehydrins At2g15970 and At4g15910 (Affymetrix reference numbers) are in this category. Thus, Paragraph [000104] provides antecedent basis for Claim 32, drawn to a method for increasing tolerance to a drought-stress condition in a plant.

## **III. The Claims Are Not Anticipated by Harper *et al.***

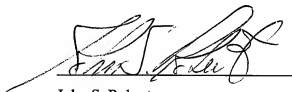
The Examiner's inherency argument seems to hinge, in part, on the assumption that Applicants' methods inhere in the composition disclosed as SEQ ID NO:2316 in Harper *et al.* If that is the assumption, it is without merit. New uses of existing products "are indeed patentable subject matter" (*Perricone v Medicis Pharm Corp.*, Fed. Cir. 2005). In its Perricone opinion, the Federal Circuit explained that the question is "not whether Pereira's lotion [the existing product] if applied to skin sunburn would inherently treat that damage, but whether Pereira discloses the application of its composition to skin sunburn." The fact is that Harper *et al.* nowhere disclose the concept of employing SEQ ID NO:2316 to upregulate or downregulate the expression of cold regulatory genes or drought regulatory genes in a plant.

The Examiner also lodges the argument that “the properties of regulating the expression of a drought or cold tolerance gene in a plant are...inherent to Harper *et al.*[‘s] method of expressing SEQ ID NO: 2316 in the transgenic plant because the active method steps recited in the instantly claimed methods are structurally identical to the method steps disclosed in [the] Harper *et al.* method.” Harper teaches a method for transforming a plant with SEQ ID NO: 2316. Claims 32 and 34 specify steps that are not taught by Harper *et al.*

### CONCLUSION

The Applicants believe that the arguments and claim amendments requested for entry herein traverse the Examiner’s rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 781.828.9870.

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John S. Roberts  
Registration No. 36,655

MEDLEN & CARROLL, LLP  
101 Howard Street, Suite 350  
San Francisco, California 94105  
781.828.9870